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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/703,804	11/01/2000	Christine C. Dykstra	5470-263	2773

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EXAMINER

DELACROIX MUIRHEI, CYBILLE

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 11/06/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/703,804

Applicant(s)

DYKSTRA ET AL.

Examiner

Cybille Delacroix-Muirheid

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 April 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) 26-48 and 50-57 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-25 is/are allowed.
- 6) ☒ Claim(s) 49, 58 and 59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4, 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### **DETAILED ACTION**

The following is responsive to Applicant's election received April 26, 2002.

1. Applicant's election of Group I with a further election of the compound represented by Formula IV in the response received April 26, 2002 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 26-48 and 50-57 are withdrawn from consideration.
3. No prior art was found for the use of Formula IV in the claimed method. The search was expanded to Formulas I-III. No prior art was found for the use of Formulas I-III in the claimed method.

### ***Allowable Subject Matter***

Claims 1-25 are free from the prior art because the prior art does not disclose or fairly suggest Applicant's claimed method.

### ***Information Disclosure Statement***

Applicant's Information Disclosure Statements received Jul. 9, 2001 and Feb. 26, 2002 have been considered. Please refer to Applicant's copies of the 1449 submitted herewith.

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PLEASE NOTE that reference 14 of the IDS received Feb. 26, 2002 was not considered because an incomplete copy of the journal was submitted. Please resubmit a complete copy so that it may be considered and made of record.

***Claim Objections***

4. Claims 1, 3-12, 14-23 and 49, 50-59 are objected to because of the following informalities: in claim 1, line 4 (after Formula IV), before "the pharmaceutically acceptable", the "and" should be deleted and replaced with --or--. Additionally, in claim 1, page 30, line 1, the "R3 and R4" should be cancelled, since these substituents are not set forth in Formulas I-IV. Finally, in claims 3-12 and 14-23, a "." should be inserted at the end of each claim.

In claim 49, page 47, line 3 (after Formula IV), before "the pharmaceutically acceptable", the "and" should be deleted and replaced with --or--. Additionally, in claim 49, page 47, line 7, the "R3 and R4" should be cancelled, since these substituents are not set forth in Formulas I-IV. Finally, in claims 50-59, a "." should be inserted at the end of each claim. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 49, 58, 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boykin et al., 6,127,554.

Boykin et al. disclose pharmaceutical compositions comprising the compounds of Formula (I), wherein "X" and "Y", which correspond to "X5" and "X6" of claim 49, are as defined and

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substituents "R1-R4" may be hydrogen. The compounds of Formula I are combined with a pharmaceutically acceptable carrier. Please see the abstract; col. 2, lines 1-54; col. 4, lines 18-22.

The claims differ from Boykin et al. by reciting a specific species and a more limited subgenus than the Boykin et al. patent. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to select any of the species taught by the reference, including those of the claims, because one of ordinary skill in the art would have the reasonable expectation that any of the species of the genus would have similar properties and thus the same use as the genus as a whole. Moreover, it has been held that a prior art disclosed genus of useful compounds is sufficient to render prima facie obvious a species falling within the genus. Please see In re Susi, 440 F.2d 442, 445, 169 USPQ 423, 425 (CCPA 1971) followed by the Federal Circuit in Merck and Co. v. Biocraft Laboratories, 87 F.2d 804, 10 USPQ 2d 1843, 1846 (Fed. Cir. 1989).

With respect to the intended use of the composition for treating IBDV, please note that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, the Examiner respectfully submits that the disclosed pharmaceutical compositions of the compounds embraced by Formula I would be capable of treating IBDV.

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***Conclusion***

Claims 49, 58, 59 are rejected.

Claims 1-25 are free from the prior art.

Claims 26-48 and 50-57 are withdrawn from consideration.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cybille Delacroix-Muirheid whose telephone number is (703) 306-3227. The examiner can normally be reached on Tue-Fri from 8:30 to 6:00. The examiner can also be reached on alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel, can be reached on (703) 308-4725. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

CDM

Nov. 3, 2002

  
Cybille Delacroix-Muirheid  
Patent Examiner Group 1600